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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,734	05/31/2000	Avner Shafir	52817.000113	2781

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/583,734	<b>Applicant(s)</b> SHAFRIR ET AL.	
	<b>Examiner</b> Tadesse Hailu	<b>Art Unit</b> 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/29/05</u> . | 6) <input type="checkbox"/> Other: _____  |

*PD*

### **DETAILED ACTION**

1. This Office Action is in response to the AMENDMENT entered on April 27, 2005 for the patent application number 09/583,734.
2. The present patent application claims priority from domestic US Application 60/137,513 filed April 2, 1999.
3. The Information Disclosure Statement submitted on April 29, 2005 is considered and entered into the File.
4. The pending claims 1-23 are examined as follows:

#### ***Response to the submitted Declaration Under 37 C.F.R § 1.131***

5. The Declaration under 37 CFR 1.131 filed on April 27, 2005 has been considered but is ineffective to overcome the ICQ, i.e., ICQ Email Signature, published May 2, 1999 reference.

To begin with, the Declaration fails to disclose all the signatures of the named inventors of the pending application.

Furthermore, the Declaration submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the ICQ Email Signature reference. The Declaration must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms without submitting evidence (in the form of exhibits) along with a general assertion to reduce the invention to practice "amounts essentially to mere pleading, unsupported by

proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Thus, the applicant fails to provide the facts that are sufficient to show reduction to practice to the invention prior to the effective date of the reference.

### **Claim Rejections - 35 U.S. C. § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis LTD, Quick Tour, February 12, 1998 in view of ICQ Inc, ICQ Email Signature, May 2, 1999.

ICQ is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact other individuals just by clicking the individual's identifier, such as by clicking individual's name or any graphical representation of the individual, such as

an icon displayed next to the individual. After clicking/selecting the individual's identifier, an interested user can communicate by sending message to the individual, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence (on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line (status indicator) as well. This status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on. Moreover, as described below, it is clear that the current claims are not distinguishable over the cited art.

With regard to claim 1:

As per "status presenting means," as mentioned above, ICQ, as described and illustrated in Quick Tour, discloses a status presentation means for presenting status indicators associated with corresponding user indicators. ICQ also provides a real-time status of the one or more target users (see Quick Tour, page 5);

as per "communication means," ICQ, as described and illustrated in Quick Tour, discloses communication means for enabling ICQ users to exchange information with a preferred or selected communication mode with a selected indicator (user indicator). Using the Internet, ICQ users can communicate with each other by clicking the name (identifier) or the icon next to it and then send a message, initiate a chat session (real-time) or launch any other interactive session (communication mode) (see Quick Tour, page 6);

as per "user indicator presentation means," ICQ, as described and illustrated in Quick Tour, discloses a user indicator presentation means for presenting a user indicator, such indicator includes among others, a name of a user, the user's numeric id (ICQ#), or any form of identification. As mentioned above these indicators allow a user to establish communication with other users on a network.

However, ICQ, as described and illustrated in Quick Tour, fails to explicitly describe enabling any other application to generate and present the status indicator within at least one electronic document, wherein the at least one electronic document is generated using any of a plurality of applications. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2). Thus, Quick Tour & Email Signature discloses "...two or more types of applications". That is, Quick Tour & Email Signature discloses that each document is generated by its associated application, that is, e-mail document is generated by e-mail application; chat document is generated by chat application, HTML document is generated by HTML application, Telephonic document is generated by telephonic application and audio-video document is generated by audio-video application.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature

to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

With regard to claims 6, 10 and 15:

Since independent claims 6, 10 and 15 include relevant limitations similar to those found in claim 1, these claims are also rejected for at least the reasons disclosed above with respect to claim 1.

With regard to claim 21:

In addition to the above independent claims recited limitations, Claim 21 further calls for "a user indicator presentation module" associated with a first system application and a status determining module associated with a second system application, wherein, the first and second system applications are different system applications. ICQ (Quick Tour & Email Signature) teaches the above limitations, wherein status can be associated with e-mail, chat or conference application that determines a status of a user associated with the user indicator (Quick Tour, page 6).

With regard to claim 22:

In addition to the above independent claims recited limitations, claim 22 further calls for "a status determining module," ICQ (Quick Tour & Email Signature) provides plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet, wherein different applications (such as voice, data sharing application) could be associated with the status of the user (Quick Tour, page 5).

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With regard to claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 17, 19 and 20:

ICQ (Quick Tour & Email Signature), as mentioned above, does provide several communication modules to a user including e-mail, chat, send and receive message files and URLs, play games, draw on whiteboards, data conference, and communicate through voice while surfing the net (Quick Tour, page 6). User can initiate or establishes any one of the communication modes he/she prefers and share at least one application with one or more users (Quick Tour, page 6).

With regard to claims 3, 8, 12 and 18:

ICQ (Quick Tour & Email Signature) automatically updates the user's status (such as online) during connection to the network. After establishing connection, user can also customize, change/update his/her status (Quick Tour, page 5).

With regard to claim 23:

In addition to the limitations recited in the above Independent claims (e.g., claim 10), claim 23 further recites a user directory that includes user information that corresponds to the plurality of target network users, wherein the user information includes user indicators. Similarly, ICQ (Quick Tour & Email Signature) discloses a contact list (a user directory) that includes user information that corresponds to the plurality of target network users, wherein the user information includes user indicators (see Quick Tour, pages 4-8). Claim 23 also recites documents generated by the two or more types of applications, wherein each document includes at least two user depictions associated with at least two target network users. Similarly, ICQ (Quick Tour & Email Signature) discloses e-mail document, chat document, web document, etc, see



Quick Tour), as per "each document includes at least two user depictions associated with at least two network users," ICQ further describes each document includes users indicator icons, (see Quick Tour, pages 4-8). Claim 23 further recites an identification-determining module, which is similar to Quick Tour in view of Email Signature name, ICQ number or contact list , see Quick Tour, pages 4-8.

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

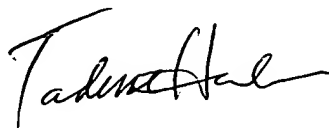
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

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10. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patent Examiner  
Tadesse Hailu  
6/23/05

A handwritten signature in black ink, appearing to read "Tadesse Hailu", written in a cursive style.